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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,638	09/13/2001	Christian Kirsten	H3544PCT/US	6355

423 7590 07/16/2003

HENKEL CORPORATION  
2500 RENAISSANCE BLVD  
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GULPH MILLS, PA 19406

EXAMINER
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WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/16/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/857,638

Applicant(s)

KIRSTEN ET AL.

Examiner

Katarzyna Wyrozebski Lee

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

***Claim Objection***

The examiner upon reviewing condensed chemical dictionary is not convinced that term coordinatively is a definite term. The objection is not withdrawn.

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 12-14, 16-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Czaplicki (US 5,985,435).

The discussion of the disclosure of the prior art of Czaplicki from paragraph 6 of the previous office action mailed on 12/24/2003 is incorporated here by reference.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 12, 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czaplicki (US 5,985,435) in view of Thakur (US 5,240,626).

The discussion of the disclosure of the prior art of Czaplicki and Thakur from paragraphs 6 and 10 of the office action mailed on 12/24/2003 is incorporated here by reference.

5. Claims 13, 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czaplicki (US 5,985,435) in view of Kelley (US 4,174,054).

The discussion of the disclosure of the prior art of Czaplicki and Kelley from paragraphs 6 and 11 of the office action mailed on 12/24/2003 is incorporated here by reference.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Czaplicki (US 5,985,435) in view of Sawai (US 4,254,201).

The discussion of the disclosure of the prior art of Czaplicki and Sawai from paragraphs 6 and 12 of the office action mailed on 12/24/2003 is incorporated here by reference.

In the amendment filed on 5/3/2003 the applicant has amended the claims to read on super paramagnetic nanoparticles. In view of the above amendment, the prior art of Czaplicki still applies against present claims, since it recites the oxide of iron as magnetic particle. Since oxide of iron is one of the nanoparticles required by the claims of the present invention, and since the properties of these particles are inherent, the oxide of iron in Czaplicki will also be super paramagnetic.

In the response to the office action mailed on 5/24/2003 the applicant has argued following:

a) The prior art of Komagata does not disclose super paramagnetic nanoparticles of the present invention.

The examiner agrees. The prior art of Komagata is overcome.

b) The prior art of Czaplicki does not teach super paramagnetic nanoparticles of the present invention.

With respect to the above argument, the examiner disagrees. The prior art of Czaplicki discloses oxide of iron as preferred particle. The properties of the compound such as metal oxides are inherent, therefore the oxide of iron will inherently be super paramagnetic.

c) The composition of Czaplicki does not lose its magnetic property if external magnetic field is removed.

With respect to the above argument, the examiner disagrees for two reasons. One, such limitation is not included in the pending claims. Two, as it was stated in b), the properties of the particles are inherent, therefore one of ordinary skill in the art would expect them to behave the same in similar situations.

d) The prior art of Thakur discloses ferrofluid, therefore there is no reason to combine Czaplicki and Thakur.

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With respect to the above argument, the examiner disagrees. The prior art of Thakur discloses not just any ferrofluid dispersion, but ferrofluid adhesive. Both disclosure of Czaplicki and Thakur are in the art of adhesives and it is well settled that it is prima facie obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Linder* 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972). In addition, the properties of the particles are inherent, therefore combination is proper.

e) The prior art of Kelly discloses hot melt adhesive that does not disclose the particles, which are paramagnetic or super paramagnetic.

With respect to the above argument, the prior art of Kelly is targeted at claims reciting the amount of the particles utilized in the composition and not its properties, although properties are inherent. The prior art of Kelly, which is also utilized to make a magnetic adhesive is further evidence that a smaller amount of nanoparticles would still result in adhesive composition.

f) The prior art of Sawai discloses pressure sensitive adhesive that contains polymer and magnetic particles. There is no inference from the combination of the references that would suggest use of very small paramagnetic or super paramagnetic particles.

With respect to the above argument, the prior art of Sawai was utilized to show that making pressure sensitive adhesive from composition of Czaplicki would have been obvious to one having ordinary skill in the art. The rejection did not address its size at all.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

KIWL  
July 1, 2003

EDWARD J. CAIN  
PRIMARY EXAMINER  
GROUP 1500

